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EXAMINER

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3623

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 35

Application Number: 08/994,047
Filing Date: December 19, 1997
Appellant(s): GARRISON ET AL.

Alfred A. Stadnicki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/16/03.

(1) Real Party in Interest

Art Unit: 3623

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11 and 13-29 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|-----------------|---------|
| 5,819,291 | Haimowitz et al | 10-1998 |
| 5,649,117 | Landry | 7-1997 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 10, 11, 14, 16-20, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by ***Haimowitz et al. (US Pat. No. 5,819,291)***.

As to ***claims 1-3, 11, 29***, all the steps recited are directed to locating a record in a database. The steps recite receiving information including a zip code and processing the information excluding the received zip code to identify an 11digit zip code to access an established database with records having a zip code to locate the record with a zip code corresponding to the identified 11-digit zip code. The recited claim has been amended to recite "locating a payee record". There is no recitation of any steps related to actually effectuating payment. Hence, the fact that the records are directed to a "payee" is not patentably significant since the record's possession

Art Unit: 3623

(i.e., to "whom" the data belongs) does not confer patentable weight to the underlying process.

Haimowitz et al. discloses a method and system for accessing existing records to match those records being received by the system to determine if there is a matching record already in the system. Haimowitz et al. teaches receiving new customer records (col. 3, Ins. 48-53) that includes a zip code (col. 3, Ins. 1-2), a zip code is generated from the address information if the zip code is missing or incorrect (col. 3, Ins. 65-67; col. 4, Ins. 6-10, 11-14, 42-51; col. 5, Ins. 1-3), a "hash code" is then generated (and later used to access the record) using the other information and the zip code validated from the zip code database (col. 5, Ins. 47). Examiner notes that Haimowitz et al. does not specify what type of zip code is used (i.e., 5-digit, 9-digit, or 11-digit). However, Haimowitz et al. discusses the following:

[i]t is given that customer classification is based on a corporate entity located at a particular **physical location**. And it follows that the hash key used to identify the possible matches should generate the set of similar corporate entities located in a similar fashion. **Thus, the hash key should be composed of attributes that describe the corporate entity and ones that describe its physical location.** (col. 5, Ins. 20-27)(emphasis added).

[U]sing the general business format provided in FIG 3, the **NAME** field is the only Corporate Entity attribute that contains data of sufficient quality to warrant consideration for hash key inclusion. Of the Location attributes, the **CITY, STATE, ZIP,** and COUNTRY fields contain the highest quality data for consideration of a hash key.

Using the above considerations, one possible hash key function is:

SUBSTR(**NAME**1,1)+COUNTRY

CODE+SUBSTR(**ZIP**,1,3) (col. 5, Ins 43-54)(emphasis added).

It is apparent from the passages above that Haimowitz et al. generates a record code using name, city, and state (i.e., the zip code) to generate and identify a record in a

Art Unit: 3623

database. Haimowitz et al. refers to this record code as a "hash key" and not as an "11-digit zip code". Since applicant is his/her own lexicographer, it is respectfully submitted that Haimowitz's "hash key" is the same as the "11-digit zip code" of the present invention since both are generated and identified using the same information (i.e., name, city, state) for the same purpose (i.e., to access a record in a database).

As to claims 4 and 5, it is noted that the recitation in claim 4 is devoid of any "steps" to further limit the method of claim 1. Rather, claim 4 merely characterizes the various data (i.e., payee record and payment information) and intended use (i.e., the database is to be accessed for...) and therefore fails to provide any patentable weight on their own. It is only in claim 5 that applicant recites a further "step" to the method of claim 1 (i.e., actually "locating" the payee record by matching the recited information). The actual recited step in claim 5 recites that the record is located by matching the "11digit zip code" with the record zip code and the name with a portion of the record name.

Haimowitz et al. teaches that once records have been classified and narrowed down using the "hash key", the reduced set is further compared with the corporate entity's name for either exact matches or phonetic-based matching (col. 6, Ins. 55-65; col. 8, Ins. 53-56).

As to **claim 10**, Haimowitz et al. teaches receiving name, address, city and state information (i.e., minus the zip code information) of the merchant (col. 4, Ins. 41-51), using the name, city and state information to generate an "11-digit zip code"

Art Unit: 3623

(i.e., "hash key"; col. 3, Ins. 61-67; col. 4, Ins. 6-14; col. 5, Ins. 42-54) to access a database to find a match (col. 6, Ins. 11-15).

As to **claim 14**, Haimowitz et al. teaches verifying that the received information, which includes account numbers, conform to the validation rules and if not, altering the data to

standardize (i.e., normalize) the data so that it conforms to the validation rule (col. 3, Ins. 12, 33-35, 54-56; col. 4, Ins. 20-24; col. 6, ln. 66; col. 8, ln. 56).

As to **claims 16-19**, these claims recite the article of manufacture comprising a computer storage medium having stored thereon a computer program causing a computer to perform the steps of claims 1, 2, 4, and 5, respectively. Since Haimowitz et al. teaches that the disclosed system is a computer based system performing the disclosed method, the same analysis applies to claims 16-19 as applied above to claims 1, 2, 4, and 5, respectively.

As to claim 20, Haimowitz et al. teaches verifying that the received information, which includes account numbers, conform to the validation rules and if not, altering the data to

standardize (i.e., normalize) the data so that it conforms to the validation rule (col. 3, Ins. 12, 33-35, 54-56; col. 4, Ins. 20-24; col. 6, ln. 66; col. 8, ln. 56).

Claim Rejections - 35 USC S 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this office action:

Art Unit: 3623

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Haimowitz et al. (US Pat. No. 5,819,291)**.

As to **claim 8**, Haimowitz et al. teaches verifying that the received information, which includes account numbers, conform to the validation rules and if not, altering the data to standardize (i.e., normalize) the data so that it conforms to the validation rule (col. 3, Ins. 12, 33-35, 54-56; col. 4, Ins. 20-24; col. 6, ln. 66; col. 8, ln. 56). Haimowitz does not specifically teach storing different alteration rules for different payees as amended. However, Haimowitz teaches that the "normalization" of the record (i.e., standard formatting) can be applied to different databases (i.e., different for a general business database as to a hospital database)(col. 3, Ins. 54-60). Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to have defined how records should be formatted (i.e., altered) in Haimowitz since Haimowitz acknowledges that different records for different databases require different formatting

Art Unit: 3623

and to automate a well known manual process is considered obvious. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261(1976) ; *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Claims 6, 7, 9, 13, 15, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Landry (US Pat. No. 5,649,117)* in view of *Haimowitz et al. (US Pat. No. 5,819,291)*.

Independent claims 1, 11, and 16, from which claims 6, 7, 9, 13, 15, and 21 depend, were rejected under §102(e) based on *Haimowitz et al.* as set forth above. In particular, although these independent claims recite a method and system for processing "payment information", none of these claims recite any positive steps or elements directed to making any payments. Therefore, rejecting these claims as recited under §102 based on *Haimowitz* is justified.

Claims 6, 7, 9, 13, 15, 21, 22, and 24 now recite specific steps and elements directed to payment processing (i.e., steps and elements for directing payments and/or remittance center selection for the payment). Therefore, the following rejection is applied based on a payment processing method and system (*Landry*) as the primary reference in view of a method and system for matching records (*Haimowitz*) as the secondary reference, instead of applying the references vice versa.

As to **claims 6, 7, 13, and 22**, *Landry* teaches a method and system for making electronic payments (see at least the Abstract). *Landry's* method and system includes setting up Payor and Payee records (i.e., accounts) that includes respective account numbers (i.e., Payor ID, Payee ID; Fig. 2A), respective address information (i.e.,

Payor address, Payee address; Fig. 2A), and respective financial institution information (Payor Bank, Payee Bank; Fig. 3). Landry's method and system processes payee information as received from the payor's payment information in setting up the payee record and uses the payee record as indicated in the payor records to process and remit payment (see at least the Abstract; col. 6, Ins. 32-54; col. 21, "ADD A CHILD-PAYEE RECORD"). Landry does not teach identifying or producing an 11-digit zip code to find a payee record in the payee database.

Haimowitz et al., as discussed above, is directed to finding an existing corporate record based on using a "hash key" derived from the business name, city and state information since doing so would expedite searching through large databases (see sections cited above in the rejection to claims 1 and 11). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have used record-matching techniques of Haimowitz et al. to the payment processing method and system as disclosed in Landry because Landry specifically teaches using a payor/payee database to locate payee information based on payor information (i.e., record-matching), which includes address information, to effectuate payment. Haimowitz et al. teaches an efficient method and system to match currently existing records to those being received. Therefore, one with ordinary skill in the art would have been motivated to use a more efficient business record-matching method and system as taught by Haimowitz to speed up and increase accuracy in an electronic payment method and system of Landry that is based on payor/payee record match.

As to claim 23, Haimowitz et al. teaches verifying that the received information, which includes account numbers, conform to the validation rules and if not, altering the data to standardize (i.e., normalize) the data so that it conforms to the validation rule (col. 3, Ins. 12, 33-35, 54-56; col. 4, Ins. 20-24; col. 6, ln. 66; col. 8, ln. 56). Therefore, the combination of Landry and Haimowitz as applied to independent claim 22 above renders claim 23 unpatentable.

As to claims 25-27, Haimowitz teaches these limitations as explained above for claims 2, 4, and 5, respectively. Therefore, the combination of Landry and Haimowitz as applied to independent claim 22 above renders these claims unpatentable.

As to claims 9, 15, 21 and 24, these claims recite a payment processing method and system for processing the payor account number to determine a single remittance center associated with the payor account number and directing a payment to the remittance center associated to the payor account number. As discussed above with respect to claims 6, 7, and 13, Landry teaches setting up Payor and Payee records (i.e., accounts) that includes respective account numbers (i.e., Payor ID, Payee ID; Fig. 2A), respective address information (i.e., Payor address, Payee address; Fig. 2A), and respective financial institution information (Payor Bank, Payee Bank; Fig. 3). Landry's method and system processes payee information as received from the payor's payment information in setting up the payee record and uses the payee record as indicated in the payor records to process and remit payment (see at least the Abstract; col. 6, Ins. 32-54; col. 21, "ADD A CHILD-PAYEE RECORD"). It is

Art Unit: 3623

notoriously old and well known in the art that merchants (i.e., payees, in this sense) have multiple banks that provide financial administrative services. Consequently, systems such as Landry, which deals with multiple payees and payors, set up a system that will look up a specific "payee" (i.e., the financial institution, in this sense) to accept the payment from a payor. That is to say, it is irrelevant whether a "payee" (i.e., a merchant) has multiple remittance centers. Landry teaches that a payor's account number (i.e., record ID) is processed to determine who is to receive the payment (i.e., Payee ID) for the merchant and directs payment to the identified entity. Landry does not teach identifying or producing an 11-digit zip code to find a payee record in the payee database as recited in the independent claims 1 and 11 from which these claims depend. Moreover, Landry does not specifically teach that a "validation rule" is stored for each payee.

Haimowitz et al., as discussed above, is directed to finding an existing corporate record based on using a "hash key" derived from the business name, city and state information since doing so would expedite searching through large databases (see sections cited above in the rejection to claims 1 and 11). Moreover, Haimowitz et al. identifies the necessity to normalize and validate the received information to alter the data, if necessary, to conform to a standardized format since the received data comes from multiple sources that may use different data structures.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have used record-matching techniques of Haimowitz et al. to the payment processing method and system as disclosed in Landry because

Art Unit: 3623

Landry specifically teaches using a payor/payee database to locate payee information based on payor information (i.e., record-matching), which includes address information, to effectuate payment. Haimowitz et al. teaches an efficient method and system to match currently existing records to those being received. Therefore, one with ordinary skill in the art would have been motivated to use a more efficient business record-matching method and system as taught by Haimowitz to speed up and increase accuracy in an electronic payment method and system of Landry that is based on payor/payee record match.

Furthermore, Landry teaches that all payment transactions must be validated (Pre-Note; col. 28, "TRANSACTION REFERENCE FILE PROCESSING") thereby identifying and acknowledging the need for validation of the payment information submitted to a financial institution. It would have been obvious to one of ordinary skill in the art at the time of the invention that multiple financial institutions do not necessarily have the same payment format as indicated in Haimowitz. Therefore, one with ordinary skill in the art would have been motivated to automate the normalization of the payment information as taught by Haimowitz to effectuate the validation process of Landry to ensure that the submitted payment is processed timely and correctly by the receiving financial institution.

Allowable Subject Matter

Claim 28 is allowed.

In particular, none of the art of record, individually or in combination, teach searching a payee database upon receipt of a payment instruction having a payee

Art Unit: 3623

name and address information, including a zip code, initially processing the payment instruction based on payee name and address information for a match in the payee database and directing payment thereto, and if no match is found, identifying an 11-digit zip code to perform a second search in the payee record for a matching payee based on the identified 11-digit zip code and directing payment thereto, as recited in claim 28.

(11) Response to Argument

In reference to Haimowitz and the identification of an eleven-digit zip code, the applicant's main argument is that the Examiner's assertion that Haimowitz's "hash key" corresponds to a zipcode is not supported by the Haimowitz disclosure or any reasonable rationale. However, as described in the previous office action, the Haimowitz reference teaches generating (i.e., identifying or producing) a "hash code" to look up certain records. One of the examples of a hash code includes using the name, city, state, and zip code to generate the hash code, which will be used to look up a record where there is a question of the provided zip code's validity or no zip code at all. *It should be noted that the previous rejection was based on the premise that this hash code was no different in substance than an eleven digit zip code because the hash code, in effect, contained the same information as that of an eleven-digit zip code, which includes the name, city, state and zip code. (See pages 14 and 15 of previous Office Action and also repeated below.) The rejection was not based on the zip code lookup feature of Haimowitz. Rather, the rejection was based on the fact that Haimowitz took the customer's data (name, address, city, state, zip code) to generate a record ID (i.e., hash*

Art Unit: 3623

code) to access already existing records in the database. This is no different that the lookup methodology recited by the present application with the exception that the record ID is an eleven-digit zip code. The applicant argues different features of the 11-digit zip code as to how the hash code of Haimowitz does not read on it. Specifically, the applicant argues that only the city and state are used to derive a zip code, that the hash code does not contain the two digits of the street address, or does not contain a building number. The applicant argues that the examiner has either ignored Haimowitz's explicit disclosure of how to generate the "hash key", or the express limitations of the present claims since applicant argues that Haimowitz explicitly discloses that only the city and state are used to derive a zip code. However, as explained in the rejection, the hash code of Haimowitz is no different in substance that an eleven-digit zip code since they both contain the same type of information (e.g., five-digit zip code + delivery sector + building number) and generated in the manner recited. Even though Haimowitz doesn't specifically mention an 11-digit zipcode, the content and the function of the hash code matches that of the 11-digit zipcode.

In addition, the applicant argues that claims 1, 11 and 16 recite that the received data is either a payor's payment information or is received from a payor and that a payee record must be located based upon information of or received from an entirely different entity. Even though there is no recitation of any steps related to actually effectuating payment, as described in the previous office action, the fact that the records are directed to a "payee" is not patentably significant since the record's

Art Unit: 3623

possession (i.e., to "whom" the data belongs) does not confer patentable weight to the underlying process.

The applicant also argues that the Examiner has not identified any disclosure within Haimowitz describing the generation of a zipcode from received address information. However, Haimowitz et al. teaches receiving new customer records (col. 3, Ins. 48-53) that includes a zip code (col. 3, Ins. 1-2), and then goes on to teach that a zip code is generated from the address information if the zip code is missing or incorrect (col. 3, Ins. 65-67; col. 4, Ins. 6-10, 11-14, 42-51; col. 5, Ins. 1-3).

The applicant also argues that the examiner's assertion the Haimowitz's "normalization" is equivalent to the alteration required is not understood. The "normalizaiton" is equivalent to the alteration required because in Haimowitz, the data is reformatted into a designated standardized format (i.e., alteration). The data is normalized based on the entity to which the data is associated (i.e., which database must be searched for the existing record, such as a general business database or hospital database. (col. 3, Ins. 54-60).

In addition, the applicant argues that in claims 8, 14, 20 and 23, there is no relevance of multiple different databases being cited when according to applicant, the claims correspond to different payees associated with the payee records in the single database. However, multiple different databases were not cited. What was cited by the examiner was that Haimowitz teaches the "normalization" of the record (i.e., standard formatting), can be applied to different databases (i.e., different for a general business

Art Unit: 3623

database as to a hospital database, which is shown in col. 3, Ins. 54-60). In this case "different" relates to a wide variety of single databases and not multiple databases.

As per claim 9, the applicant argues that Landry lacks any suggestion of the selection of one of multiple remittance centers for a particular payee. As recited, the claimed "remittance centers" are receiving the payment (i.e., opposed to a payment advice or payment instructions). Therefore, construing the remittance centers as **recited** to be financial institutions is not an unreasonable claim construction. Reading the claims in this light, corporate payees usually have more than one financial institution accounting for received payments, whether that institution is a third party bank or an in-house accounting department. All electronic or physical payments are routed to the appropriate financial institution designated by the payee. Examiner's Official Notice was based on this fact and therefore it would have been obvious for one with ordinary skill in the art to route the payments to the correct financial institution for payment.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 08/994,047
Art Unit: 3623

Page 17


Respectfully submitted,

Alb.

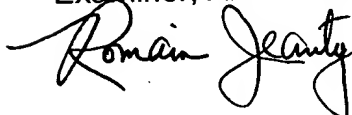
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August 11, 2003

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